

Notice of Allowability

Application No.

09/854,280

Applicant(s)

CHEN ET AL.

Examiner

Art Unit

Dong Jiang

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to response filed on 4/3/06.
2. ☒ The allowed claim(s) is/are 61-72 to issue as 1-12, respectively.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>5/4/06</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>4/3/06</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED OFFICE ACTION

Applicant's response filed on 03 April 2006 is acknowledged.

Currently, claims 61-72 are pending and under consideration.

Withdrawal of Objections and Rejections:

The prior art rejection of claims 61-63 and 68-72 under 35 U.S.C. 102(e) as being anticipated by Ebner et al., US 2003/0092133 A1 is withdrawn in view of applicant's argument.

The prior art rejection of claims 64-67 under 35 U.S.C. 102(e) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Ebner et al., US 2003/0092133 A1 is withdrawn in view of applicant's argument.

Examiner's Statement of Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

Claims 61-72 of the present invention are directed to isolated nucleic acid sequences having a nucleotide sequence of SEQ ID NO:4, or encoding the polypeptide of SEQ ID NO:3, variants thereof, a vector containing said nucleic acid, host cells thereof, and a process for recombinantly producing the encoded polypeptide, which is designated PRO1122, and is capable of inducing the production of TNF- α .

The prior art rejections of claims 61-72 under 35 U.S.C. 102(e)/103(a) as being anticipated by, or being unpatentable over Ebner et al., US 2003/0092133 A1 were made previously because Ebner discloses a nucleic acid sequence, SEQ ID NO:28, which is 99.8% identical to the nucleotides 50-640 of present SEQ ID NO:4, and encodes a polypeptide of SEQ ID NO:29 (IL-21) 100% identical to the present SEQ ID NO:3. The Ebner application has an effective filing date of 9/10/98 (sequence disclosed, 60/099,805), which predates the effective filing date of instant invention, 12/23/98 (60/113,621).

Applicants filed declaration on 31 October 2003 under 37 CFR 1.131. Given the current condition of the Ener application, which no longer claims the same invention as that of the

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present application (as indicated in the argument of the instant response), applicants declaration is sufficient to overcome the Ebner reference.

Further, no other prior art has been identified that teaches or suggests the nucleic acid of SEQ ID NO:4, or the nucleic acid encoding the polypeptide of SEQ ID NO:3, nor the recombinant expression and biological function of SEQ ID NO:3.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion:

Claims 61-72 are allowed.


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Advisory Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on 9:30 am - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LORRAINE SPECTOR
PRIMARY EXAMINER

Dong Jiang, Ph.D.
Patent Examiner
AU1646
5/4/06